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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,539	06/09/2000	Tina Marie Nielsen		3228

7590 07/12/2004
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EXAMINER

ARNOLD III, TROY G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 07/12/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/591,539
Filing Date: June 09, 2000
Appellant(s): NIELSEN ET AL.

Robert E. Howard
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 22, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 15-28 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

4273380	Silvestri	6-1981
5,072,467	Hunt	12-1991
5,346,308	Buhot et al	9-1994
5,414,881	Terrazas	5-1995
D359,411	Wade	6-1995
5,644,807	Battistella	7-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wade in view of Hunt. Wade teaches all the limitations of claim 15 except a) the case being attached inwardly of the first end of the sheet and b) the open first end of the carrying case facing a longitudinal edge of the sheet. Hunt teaches a case 26 which is attached inwardly of the first end of a sheet 12, with the openable end facing the top edge. It would have been obvious in view of Hunt to

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one of ordinary skill in the art at the time the invention was made to make the case of Wade attach inwardly of the first end of the sheet for the purpose of allowing it to better function as a pillow, should it be used in that manner. It would have been obvious to rotate the case of Wade 90 degrees and around the edge of the sheet, so that it faced a longitudinal edge of the sheet, for the purpose of allowing the case to be more conveniently used as a storage bag, when someone is lying on the sheet.

Claims 16-28 are rejected under 35 U.S.C. 103(a) in the same manner as in Non-Final Rejection, Paper No. 8, dated February 28, 2002. Additionally, the following rejections are also made:

Claims 15, 18, 20, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt. Hunt teaches all the limitations of claim 15 except the open first end of the carrying case facing a longitudinal edge of the sheet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to rotate the case 26 of Hunt 90 degrees so that it faced a longitudinal edge of the sheet, so that it might be more conveniently accessed when someone is lying on the sheet. The rotation of an element in such a manner is clearly within the capability of one of ordinary skill in the art. (Further, it is noted that there is no apparent criticality to the open end of the case of the Applicant's invention facing the longitudinal edge of the sheet.) Regarding claim 18, see items 22 and 24. Regarding claim 20, it would have been obvious to one of ordinary skill in the art at the time the invention was made to move the pockets 22 and 24 inwardly a small distance from the longitudinal edges of the sheet; this

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would appear to be simply a matter of design choice. Regarding claim 21, the end portion 48 will act as a carrying means attached to the case, adjacent the open end. Regarding claim 24, were the sheet of Hunt reversed and stuffed inside the case 26, the strips 50 and 52 on the flap 48 and portion 30 could secure the flap to the front wall of the case.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt as modified regarding claim 15, in view of Wade. Hunt as modified teaches all the limitations of claims 16 and 17 except a slip cover pocket at the first and second ends of the sheet. Wade teaches a slip cover pocket at the first end of the sheet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a slip cover pocket as taught by Wade into the invention of Hunt for the purpose of allowing the sheet to be better restrained in wind, on any item such as a chair. Adding a slip cover pocket to the other second end is mere duplication, and would have been obvious for the same reason.

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Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt as modified regarding claim 15, in view of Terrazas. Hunt as modified teaches all the limitations of claim 23 except a waterproof sheet attached to the bottom of the flexible sheet. Terrazas teaches a sheet with a waterproof layer for a similar purpose. It would have been obvious to one of ordinary skill in the art at the time the invention was made to put a waterproof layer on the bottom of the sheet of Hunt in order to protect the user from moisture on a surface being rested on.

(11) Response to Arguments

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Contrary to the remarks at the bottom of page 6, we do not believe towel 60 of Wade is attached to the sheet 12 at 64 (using Applicant's numbering system for Wade filed with Appeal Brief dated January 16, 2003) or that the cover 12 is not attached to the tote bag 20. Applicant assumes that case 20 of Wade is attached to sheet 12 (only) by means of cloth 60. Applicant has no grounds on which to base this assertion. We believe that sheet 12, case 20, and cloth 60 of Wade are all attached together at point 62.

Contrary to the remarks at the top of page 7, we believe that at least some (however small) portion of the inner surface of a wall of the case 20 of Wade will be permanently attached to the sheet 12, as noted above. At point 62, the edge 14 of the cover 12 will be sewn to some (however small) portion of the inner surface of the wall 21 or 22 of the case 20. See Figs 3 and 4.

Contrary to the remarks at the top of page 7, regardless of the various functional "use modes" claimed by the Applicant, it is maintained that Wade's case 20 will be reversible by pulling it inside out, thus satisfying the limitations of the claims.

Regarding the remarks at the bottom of page 7, it is submitted that Hunt fairly suggests modifying Wade. Hunt's invention is an analogous flexible sheet and carrying case combination. Specifically Hunt teaches a storage case 26 which is attached inwardly of a first end of a sheet 12. There is nothing to prevent turning the case 26 of Hunt inside out and storing the sheet 12 therein. It is submitted that it would have been obvious in view of Hunt to one of ordinary skill in the art at the time the invention was made to move the case 20 of Wade

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inwardly of the end for any of a number of reasons, such as allowing the case 20 to better function as a pillow. The exact location and orientation of the case / pillow of Wade would also appear to be a matter of design choice – several of the references teach different locations and orientations of similar pockets.

Contrary to the remarks at the bottom of page 7, it is maintained that the case 20 of Wade could easily be used as a pillow, and furthermore that it would have been obvious to do so. It could be used as a pillow if flipped over in the position shown in the drawings, or also in the inward position, as modified by Hunt. Contrary to the remarks, were the case 20 of Wade pushed inside out, the outer surface of the carrying case would form the inner surface of the pillow case, as required by the claim.

None of the Applicant's arguments from page 8 to the middle of page 11 explain why the original rejections of claims 15 and 25 are deficient. It has been shown that Wade as modified satisfies the limitations in the claims. Applicant's arguments in this section fail to show that any of the supplemental references further modifying Wade are improperly combined, and therefore these arguments are unconvincing.

Contrary to the remarks at the top of page 12, it is submitted that Hunt's towel could in fact be fitted inside the reversed envelope 26, especially if the fabric were thin, like silk. Regarding the remarks at the bottom of page 12, it is submitted that it would have been obvious to rotate Hunt's envelope 26 so that the opening faced another direction, for any of a number of reasons; this would appear to be a simple matter of design choice, but might result from utility

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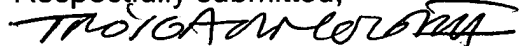
reasons as well, such as better access to the pocket when someone is lying on the cover. See paragraph above relating to the exact placement of the case / pillow.

Applicant's arguments at the top of page 13 fail to show how Hunt's flap structure (48,50 and 52) will not function if the envelope 26 is reversed. Inside of flap 48 will still contact strip 50, only on the *inside* of the (reversed) case, a condition not restricted by the claim language.

The remaining remarks on page 13 fail to address any new substantive issues. Applicant's arguments in this section fail to show that any of the supplemental references further modifying Wade are improperly combined, and therefore these arguments are unconvincing.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Troy Arnold
Examiner
Art Unit 3728

TGA
July 8, 2004

Conferees
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